

REMARKS

Claims 1-9 were pending in the subject application. Applicants have canceled non-elected claims 8 and 9 without disclaimer or prejudice to applicants' right to pursue the subject matter of these claims in this or in another application. Applicants have also amended claims 1-3. The amendments to claim 1 are supported in the specification of the published application (Publication No. 2006/0111536 A1) at paragraphs [0008], [0019] and [0119], and in claim 1 as originally filed. Other amendments to claim 1, and the amendments to claims 2 and 3, merely involve minor formatting changes. Thus, the above amendments do not present any new matter. Accordingly, applicants respectfully request that this Amendment be entered into the application. Upon entry of this Amendment, claims 1-7 will be pending and under examination.

Rejection of Claims 1-3, 5 and 6 under 35 U.S.C. §102

The Examiner rejected claims 1-3, 5 and 6 under 35 U.S.C. §102 as allegedly anticipated by U.S. Patent No. 4,184,004 to Pines et al. (henceforth "Pines").

Applicants respectfully traverse this rejection. Applicants note that independent claim 1 has been amended to clarify the subject matter of the invention being claimed. Thus, claim 1, as amended, and claims 2, 3, 5 and 6 dependent therefrom, recite an organic polymer having epoxy-containing silicon groups at its ends. As disclosed in the specification, the organic polymer of the present invention has epoxy-containing silicon groups at its ends, *i.e.*, at two or more of its ends. See Publication No. 2006/0111536 at, for example, paragraphs [0008], [0019], and [0119]. Further, specific organic polymers having epoxy-containing silicon groups at two or more ends are exemplified in Synthetic Examples 5, 6, 7, and 9 of the specification.

In contrast, applicants assert that Pines neither discloses nor suggests a polyoxyalkylene having epoxy-containing silicon groups at two or more ends. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See M.P.E.P. §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Since Pines does not teach a

polyoxyalkylene having epoxy-containing silicon groups at its ends, applicants maintain that this reference does not anticipate the now pending claims. Accordingly, applicants respectfully request that the present ground of rejection be withdrawn.

Rejection of Claim 4 under 35 U.S.C. §103(a)

The Examiner rejected claim 4 under 35 U.S.C. §103(a) as allegedly obvious over Pines, as applied to claims 1-3 and 5-7 above, and further in view of U.S. Patent No. 4,803,244 to Umpleby ("Umpleby"). The Examiner stated that Pines teaches the basic claimed polymer as set forth above, but does not teach a polysiloxane copolymer with a skeleton portion comprising a saturated hydrocarbon polymer selected from the group consisting of polyisobutylene, hydrogenated polyisoprene, hydrogenated polybutadiene and hydrogenated copolymers thereof. The Examiner further stated that Umpleby, however, teaches hydrosilation chemistry commonly used in the art to form polyolefinic/polysiloxane copolymers.

Applicants respectfully traverse this rejection. Applicants note that in accordance with M.P.E.P. §2142, obviousness requires that three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge of a skilled artisan, to modify the reference or to combine reference teachings. (This suggestion or motivation need not be expressly stated in one or all of the references used to show obviousness, *per KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1731-2 (2007)). Second, there must be a reasonable expectation of success. Third, the prior art reference, or references when combined, must teach or suggest all the claim limitations.

As noted above, independent claim 1, as now amended, recites an organic polymer having epoxy-containing silicon groups at its ends. Claim 4, which depends from claim 1, therefore also recites this element. However, Pines does not teach a polymer having functional groups at its ends, and this deficiency is not cured by Umpleby. Thus, the combination of Pines and Umpleby does not teach or suggest all the elements of claim 4, and thus fails at least one requirement for establishing a case of obviousness.

Moreover, applicants note that the organic polymer of the present invention exhibits excellent curability. See paragraph [0019]. In general, a polymer containing only one functional group (such as epoxy-containing silicon groups) does not exhibit excellent curability because it cannot form a polymer network with other polymer molecules. In order to obtain a polymer network, a polymer must have functional groups at two or more of its ends. Since neither Pine nor Umpleby discloses such a polymer having functional groups at two or more of its ends, the polymers disclosed in these references do not exhibit excellent curability. In fact, Pine's invention relates to a "textile material having improved durable softness and water absorbancy," see claims 15-28, which does not require that the polymer itself exhibit curability. Applicants maintain that Pine's polymer is considerably different from that of the present invention, and that the combination of Pines and Umpleby does not suggest the claimed invention.


For at least the reasons set forth above, applicants maintain that claim 4 is not obvious over the combination of the cited art. Applicants therefore respectfully request withdrawal of the present ground of rejection.

CONCLUSION

In view of the above remarks, applicants respectfully request that the Examiner reconsider and withdraw the rejections set forth in the July 19, 2007 Office Action. Applicants respectfully submit that the now pending claims are in condition for allowance, which action is earnestly solicited.

If a telephone interview would assist in expediting prosecution of the subject application, the Examiner is invited to telephone the undersigned at the number provided below. No fee is deemed necessary in connection with the filing of this Amendment. However, in the event that the filing of this paper is deemed not timely, applicants petition for an appropriate extension of time. Authorization is hereby given to charge the petition fee and any other fees that may be required in relation to this paper to Kenyon & Kenyon Deposit Account No. 11-0600.

Respectfully submitted,
KENYON & KENYON LLP


Ashton J. Delauney
Recognition No. L0227

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One Broadway
New York, New York 10004
(212) 425-7200 (telephone)
(212) 425-5288 (facsimile)
CUSTOMER No. 26646